REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. Change of Power of Attorney.

Applicant's counsel has been changed to the patent practitioners within the law firm of O'Banion and Ritchey to continue prosecuting the instant application. This change was recorded with revocation of the previous power of attorney and registering a new power of attorney, wherein all communication should be directed accordingly.

2. Objection to Drawings.

The attached sheets of drawings comprise replacement sheets as indicated by the Examiner in requiring *"New corrected drawings"*.

Although the Applicant is submitting a replacement set of drawings as per Examiner requirement, the Applicant finds this to be an unusual request for a couple of reasons.

(1) Examiner comments with regards to the drawings are somewhat confusing. Examiner indicates that *"...this application has been filed with informal drawings which are acceptable for examination purposes only"*, yet Examiner goes on to indicate that new drawings are required. However, if the drawings are acceptable for Examination then why is the Examiner requiring new drawings?

(2) It should also be noted that there is no longer any requirement for submittal of "formal" drawings, and there was no indication in the action as to specific problems with the existing drawings. Referring to MPEP 608.02(b) Informal Drawings, it is stated that *"the Office no longer considers drawings as formal or informal. Drawings are either acceptable or not acceptable. Drawings will be accepted by the Office of Initial Patent Examination (OIPE) if the drawings are readable and reproducible for publication*

purposes See MPEP § 507." Therein only problems in the existing drawings need be addressed in this manner.

3.   <u>Rejection to Claims 1, 4-9, 21, 36 and 37 under 35 U.S.C. § 103(a).</u>

Claims 1, 4-9, 21, 36 and 37 were rejected as being unpatentable over Hans et al. (U.S. Published Patent App. No.: US 2002/0120577).

<u>Claims 1, 21, 36 and 37</u>.   Independent Claims 1, 21, 36 and 37 are rejected based on the Hans reference.

A number of shortcomings become readily apparent when considering this rejection. In particular (1) all claim limitations are not taught, (2) rejection based only on partial similarity of inventive concept or idea, (3) invention is not considered as a whole, (4) advantages are disregarded, (5) different principle of operation utilized, (6) solved a different problem, (7) lack of specificity of suggestion to modify, (8) "plain meaning" of recited elements ignored, (9) elements in reference are not equivalent, (10) claim elements improperly considered non-functional, and (11) no *prima facie* case of obviousness has been established. Any of these shortcomings separately are sufficient to overcome the rejection, whereas taken together are they are overwhelmingly indicative of patentability.

The following discusses with greater particularity certain shortcomings.

DIFFERENT OBJECTS AND PRINCIPLES OF OPERATION

In considering the claims of the instant application as a whole, the purposes and principles of operation of the invention and the relied upon reference must be compared.

The purpose of Hans is stated succinctly in the Abstract: *"enables users to register previously owned digital content and, subsequently, allows user to access the registered content using any electronic device that is connected to the system"*. Hans describes rights and royalty management in relation to content access. Operation of

the Hans reference is based on the principle of licensing content over the Internet for content which can be communicated electronically.

However, the instant application is drawn to a system and method of providing notification functions for electronic music marker devices. The operating principle of the instant application is that of collecting music clips from broadcast playlists in response to data marks contained within a data marking device of the user. In addition, notification is provided to the user based on the availability of the music clip information. If the desired playlist is not currently available, the system is configured to determine when the playlist becomes available and to notify the user, such as by email.

Consequently, it can be readily recognized that the relied upon Hans reference operates toward different inventive objects and principles of operation than the instant application. Hans relies on licensing a user for specific content, and provides no operating principles which relate to collecting music clips from playlists in response to a data mark from a data marking device.

In support of the rejection the Examiner has claimed that Hans teaches all the claim elements, excepting the use of data marks and playlists as recited in Applicant's claim which Examiner notes *"these limitations are not structurally involved in the elements of the recited system"*.

ELEMENTS HAVE STRUCTURAL INVOLVEMENT TOWARD RESULT

Applicant respectfully traverses this grounds for rejection in a number of important regards.

(a) First, giving no patentable weight to the problem being solved clearly flies in the face of numerous examination tenets, including consideration as a whole.

The instant application, entitled "Electronic Music Marker Device Delayed Notification" is generally directed at generating notification when a playlist is not available in response to communicating data marks from a data marking device.

Furthermore, the device can generate notification when the playlist becomes available.
Clearly, "playlists" and "data marks" are functional elements - they are interconnected
and they provide functionality which is critical to the practice of the invention.

Turning to the MPEP for guidance in this area it is seen from MPEP 2106
Patentable Subject Matter - Computer-Related Inventions [R-2] - 2100 Patentability that
two aspects must be carefully considered in order to assess "nonfunctionality".

(1) First factor is whether the invention as a whole has utility value.
This is stated in the MPEP 2106 as the following:
> "The claimed invention as a whole must accomplish a practical application. That
> is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d
> at 1373, 47 USPQ2d at 1601-02"

(2) Secondly, do the elements form a part of a practical result.
This is stated in the MPEP2106 as follows:
> "Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent
> eligibility standard requires significant functionality to be present to satisfy the
> useful result aspect of the practical application requirement. See Arrhythmia, 958
> F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive
> material stored in a computer-readable medium does not make the invention
> eligible for patenting. For example, a claim directed to a word processing file
> stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the
> information stored may have some "real world" value. However, the mere fact
> that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean
> that a useful result is achieved under the practical application requirement. The
> claimed invention as a whole must produce a "useful, concrete and tangible"
> result to have a practical application."

The MPEP refers to the data interaction by considering that the claimed
invention as a whole must produce the "useful, concrete and tangible" result. Data
which is being manipulated within the invention can clearly not be construed as non-
functional. In this case the Examiner is attempting to consider both the tangible result
(playlist), and the input (data mark) received for generation of the tangible result as
being non-functional elements.

The aspects of data marks and playlists are defined clearly in the specification, while Claims 2-3 provide further clarification of these aspects, but have been improperly held to be a separate species by the Examiner (although the material incorporated within original independent Claims 36-37).

Consequently, there is no support for considering the element to be non-functional.

NOT ALL CLAIM LIMITATIONS RECITED

(b) Secondly, the elements of Hans do not equate to those recited in Applicant's Claim 1. Specifically, Examiner puts forth that in paragraph [0025] Hans describes *"a server terminal coupled to said gateway terminal configured to receive said one or more data marks and generate a user playlist"*.

However, Hans does not describe a server terminal which in response to data marks generates playlists. Hans does describe that *"Content manager 11 may be configured to allow a user to create playlists or otherwise organize the digital content that is registered with content manager 11."* Yet, the structural relations recited in Claim 1 *(as required in establishing a Prima Facie case of obviousness)* are not taught by Han, specifically there is no server terminal that converts data marks to generate a playlist.

In addition, the second claim element of a "playlist provider" has been ignored and not considered in the claim relation. Again the Claim has been improperly examined, in that ALL claim elements must be properly considered and find support in the relied upon reference, or references.

Accordingly, it is asserted that the Examiner has not established a *prima facie* case of obviousness with respect to Claim 1 for the above reasons.

(c) Claim 1 has been amended. Despite the lack of a *Prima Facie* case of obviousness being made, Applicant has amended Claim 1 to improve clarity and to capture the "delayed notification" aspect which was a primary intent of the instant application - as indicated by the Title. Although these limitations have not been added to overcome the cited reference, it should be appreciated that the additional details provide additional distinguishing elements. For example, the original claim did not describe searching for music clips based on the data marks within the broadcast playlist, and did not distinguish between a broadcast playlist and a user playlist. It is intended that the amended claim will bring clarity to the operation of the server terminal, in particular that it searches for music clips in the broadcast playlists based on the data marks. Information is collected about the music clips into a user playlist.

The delayed notification aspect is recited as being a means of notifying the user by email when playlists associated with the data marks being searched for become available.

Therefore, independent Claim 1 is patentably distinct from the reference and the Applicant respectfully requests that the rejection of Claim 1 and claims which depend therefrom be withdrawn.

Claim 21. Independent Claim 21 is drawn to "*a delayed data mark playlist notification system*".

The shortcomings of the rejection of Claim 1 also generally apply to Claim 21. Furthermore, Claim 21 contains elements which were not recited in Claim 1, wherein additional grounds for traversing the rejections become apparent.

(a) Elements of Claim 21 cooperate to produce a result that both has utility and operates to form a practical result; therein these elements are not "nonfunctional".

(b) Hans is silent about the use of "data marks", "generating corresponding user playlist (from the data mark)", and of the playlist containing music clip information with music clip name, artist, and/or album.

(c) The silence of the Hans is not surprising in that Hans is directed at a different purpose with different operating principles. As described previously Hans is directed at a mechanism for licensing content over the internet. There is no teaching in Hans for the use of a data marking device, and further no teachings of looking up music clips from a playlist in response to data marks, and still further no discussion of providing notifications with regard to the availability of the music clips.

Accordingly, a *prima facie* case of obviousness has not been established as the relied upon Hans reference does not support the obviousness rejection.

In addition Claim 21 was also amended to capture the delayed notification aspect of the invention. The claim describes in further detail the sending of notifications to the user by the programming of the server terminal.

Therefore, Claim 21 is not obvious in view of the relied-upon reference and the rejection of Claim 21 and the claims which depend therefrom should be withdrawn.

Claim 36. Independent Claim 36 is drawn to "data marking device notification system".

The shortcomings of the rejection of Claims 1 and 21 also apply to Claim 36. Claim 36 is cast in a mean-plus-function format.

(a) Elements of Claim 36 cooperate to produce a result that both has utility and operates to form a practical result; therein these elements cannot be properly considered "nonfunctional".

(b) Hans is silent about the use of "data marks", "generating corresponding user playlist (from the data mark)", and of the playlist containing music clip information with music clip name, artist, and/or album.

(c) Again, the silence of the Hans reference in this regard is not surprising in that Hans is directed at a different purpose with different operating principles.

Accordingly, a *prima facie* case of obviousness has not been established.

In addition Claim 36 was also amended to clarify claim elements, such as to distinguish broadcast playlist from user playlist and to capture the delayed notification aspects of the invention. The claim describes in further detail the sending of notifications to the user by the programming of the server terminal.

Therefore, Claim 36 is not obvious in view of the relied-upon reference and the rejection of Claim 36 and the claims which depend therefrom should be withdrawn.

Claim 37. Independent Claim 37 is drawn to a "delayed data mark playlist notification system".

The shortcomings of the rejection of Claims 1, 21, and 36 also apply in general to Claim 37, which like Claim 36 is also written in a means-plus-function format.

(a) Elements of Claim 37 cooperate to produce a result that both has utility and operates to form a practical result; thereby these elements are not "nonfunctional".

(b) Hans is silent about the use of "data marks", and more particularly data marks containing a time stamp and date stamp "generating corresponding user playlist (from the data mark)", and of the playlist containing music clip information with music clip name, artist, and/or album.

(c) The Hans reference is directed at a different purpose with different operating principles than those found in the elements of Claim 37.

Accordingly, a *prima facie* case of obviousness has not been established.

In addition Claim 37 was also amended to clarify claim elements, such as to distinguish broadcast playlist from user playlist and to capture the delayed notification aspects of the invention. The claim describes in further detail the sending of notifications to the user by the programming of the server terminal.

Therefore, Claim 37 is not obvious in view of the relied-upon reference and the rejection of Claim 37 and the claims which depend therefrom should be withdrawn.

Claims 4-9.   Dependent Claims 4-9 contain additional limitations. In view of the discussed patentability of Claim 1, each of these dependent claims should be considered a fortiori allowable.

Furthermore, a number of elements of these claims provide separate grounds for patentability and do not comport to aspects of the relied-upon reference.

Claims 4-5. Dependent Claims 4-5 describe the inclusion of a data marking device identification code which is transmitted to the server terminal. This feature is equated to an IP address within the system of Han. However, an IP address is not the same as an identification code, unless the device is IP based and uses the IP address for that purpose. IP addresses, as taught by Han, are not used to discern user characteristics and/or location.

Claim 6. Dependent Claim 6 describes the use of the identification code within the server to determine geographic location. The utility of this feature is easily recognized from the use of the device in the specification. The data marking device is configured to input data that can be converted to a means of locating a music clip, for instance a time mark and unit identification, wherefrom music clips are determined from geographic location based on the identification code and information entered by the user as to their location. The location being used to determine the set of broadcasters from which the broadcast playlists are collected for the times associated with the time marks. Applicant has amended Claim 6 to add this object of the identification code.

Accordingly Claim 6 provides a utility and operates to form a practical result, therein Claim 6 can not be considered to lack structural involvement.

Claims 7-9. Dependent Claims 7-9 describe retrieving and using broadcast call letters in response to geographic information based on the identifier as recited in Claim

6. These limitations again provide utility and are structurally involved, however, these claim elements have been improperly ignored.

Therefore, dependent Claim 4-9 should be considered *a fortiori* allowable, while they also recite elements not found in the reference. Either of these conditions overcome the rejection, wherein the rejection of these claims should be withdrawn.

4.   Traversal of Rejection of Claims 1 and 36-37; In re Donaldson.

The Applicant respectfully traverses the grounds for rejection, and cites *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc) as the basis for the traversal. Claims 1 and 36-37 are written in means plus function form pursuant to 35 U.S.C. §112, sixth paragraph, and therefore, must be interpreted during examination under *In re Donaldson*.

In rejecting Claims 1 and 36-37, as well as the claims that depend therefrom, the Examiner made no specific fact findings as to the scope of equivalents for the means plus function elements in the claims. Instead, the Examiner appears to have followed the provisions of MPEP § 2183 ("Making a Prima Facie Case of Equivalence"), which states:

> If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed limitation is anticipated by the prior art element. The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure ... disclosed in the application. *In re Mulder*, 716 F.2d 1542, 219 U.S.P.Q. 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant disagrees with the examiner's conclusion, and provides reasons why the prior art element should not be considered an

equivalent.

While the Examiner appears to have followed the provisions of MPEP §2183, such provisions are contrary to Federal Circuit law. The Federal Circuit has held that an examiner "construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure ... described therein, and equivalents thereof," *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc), and in so ruling expressly denied that "the PTO is exempt from this mandate." Id. The Federal Circuit added that it was specifically overruling any precedent that suggested or held to the contrary. Id. at 1193-94. In response to the PTO's argument that the court's ruling conflicted with the principle that a claim should be given its broadest reasonable interpretation during prosecution, the Federal Circuit held that the Donaldson decision was setting "a limit on how broadly the PTO may construe means-plus-function language under the rubric of 'reasonable interpretation.'" Id. at 1194. In other words, an examiner's claim interpretation is not "reasonable" if it is not based on the specification's description of the implementation of the means element of the claim. The court then said, "Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such [means-plus-function] language when rendering a patentability determination. " Id. at 1195.

Here, as in *Donaldson*, the Examiner is required by statute to look to the Applicant's specification and construe the "means" language as referring to corresponding means disclosed in the specification and equivalents thereof." See id. at 1195. However, the Examiner did not construe the means language of these claims, however. Nor did the Examiner find, on the basis of specific facts of record here, that the means disclosed in the Applicant's specification were equivalent to that of the cited references. Instead, as prescribed by MPEP §§ 2183-84, the Examiner simply presumed equivalence. The presumption methodology used here, which the MPEP

prescribes, clearly conflicts with the requirements of the Federal Circuit's Donaldson decision. The approach taken by the Examiner in this case also conflicts with *In re Bond*, 931 F.2d 831 (Fed. Cir. 1990).

The very point of these cases is that, in this context, limitations from the specification control the interpretation of the claim. Under §112, paragraph 6, a means-plus-function element of a claim must be construed to mean that which is disclosed in the specification and its equivalents. In *Donaldson*, the Federal Circuit said that "our holding does not conflict with the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim." In other words, the court was saying that a §112, paragraph 6 "means" element does not need to be "imported or read into" a means-plus-function claim because the specification's limitations and their equivalents are already in the claim by virtue of §112, paragraph 6's command. Thus, the Federal Circuit said (16 F.3d at 1195): "What we are dealing with in this case is the construction of a limitation already in the claim in the form of a means-plus-function clause and a statutory mandate on how that clause must be construed."

Based on the foregoing, the Applicant respectfully submits that the rejection of Claims 1 and 36-37, as well as the claims that depend therefrom, lacks proper foundation and that the rejection should be withdrawn. Those claims, each of which include means plus function limitations, should have been interpreted in view of the specification as required by *In re Donaldson*. If those claims had been so interpreted, they would have been allowable since the cited references do not, singly or in combination, teach, suggest or provide motivation or incentive for the subject matter recited in those claims.

5.   Amendments to Claims 1, 6, 21 and 36-37.

Claim 1.   Independent Claim 1 was amended to clarify claim elements, and to capture the delayed notification aspect of the invention.

In addition the meaning of the playlist is further defined as including "information on at least one music clip" which is also recited in Claim 37.

Support for these changes is found throughout the specification, including:

FIG. 10, blocks 1030, 1060 - 1080 illustrate determination of playlist availability and the communication of notifications for not available, or emails when playlist becomes available, which is described in the specification at page 15 lines 6-16:

"At step 1070, controller 145 of server terminal 140 continues to periodically query storage unit 144 to determine whether the playlists for the bookmarked music clips are available, and when controller 145 determines that the corresponding playlists for the user's bookmarked music clips are available, controller 145 in one embodiment is configured to retrieve the user's email address stored in user account database 600 in storage unit 144 and to generate an email notification to the user with a message indicating that the requested information corresponding to the bookmarked music clips is available. Controller 145 in one embodiment may also generate a hypertext link to the user's e-marker.com account and attach the generated link to the email notification to the user."

and the transmission of information about the music clips at page 7, lines 11-14:

"In particular, for music broadcasts from registered radio stations prior to 10 PM, playlist provider 150 may be configured to transmit information corresponding to the broadcast music clips to the server terminal 140 by 5 AM (at playlist provider 150) of the following day."

as well as searching for playlists associated with the data marks at page 2, line 25: "search for playlists corresponding to said one or more data marks".

Claim 6.   Dependent Claim 6 was amended to clarify the intent of determining geographic location. Support is found throughout the specification, such as at page 11, lines 18-25:

"As will be discussed in further detail below, depending upon the feed type assigned for each geographic location, playlist provider 150 is configured to transmit information corresponding to broadcast music clips to server terminal 140 for transmission to the users via gateway terminal 130 within the assigned time frame (for example, within 10 minutes of broadcast in geographic location such as San Francisco, California, or alternatively, within a predetermined time frame (next-day feed type) for geographic location such as Vail, Colorado."

Claim 21.   Independent Claim 21 was amended to clarify the difference between broadcast playlist and user playlist. In addition, the claim was amended to capture the notification aspect of the present invention as similarly recited in amended Claim 1.

Claim 36.   Independent Claim 36 was amended to clarify the difference between broadcast playlist and user playlist. In addition the claim was amended to capture the notification aspect of the present invention as similarly recited in amended Claim 1.

Claim 37.   Independent Claim 37 was amended to clarify the difference between broadcast playlist and user playlist. In addition, the data marks are noted as being "input by a user" to more readily support description of the user elsewhere in the claim. Support for this aspect is found throughout the specification, such as at page 7 lines 29-32: *"Also provided on body 201 are display panels 204a and 204b which are configured to display the number of user inputted e-marks and the type of registered broadcast station for the corresponding e-marks, respectively."*

Furthermore, Claim 37 was amended to capture the notification aspect of the present invention as similarly recited in amended Claim 1.

6.   Request for Additional Information.

Examiner puts forth a request for additional information.

Applicant notes that there are three elements (a-c) listed with the request, however, the first two elements relate to "a computer network to select a catalytic converter substrate or diesel particulate filter", which is not applicable to the present case. Applicant is therefore unable to respond to this request.

In part (c) Examiner requests additional information about the electronic music marker device.

Applicant has included within the appendix articles which were found on the World Wide Web describing the data marking system of Sony.

7.   Amendments Made Without Prejudice or Estoppel.

Notwithstanding the amendments made and accompanying traversing remarks provided above, Applicant has made these amendments in order expedite allowance of the currently pending subject matter. However, Applicant does not acquiesce in the original grounds for rejection with respect to the original form of these claims. These amendments have been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed or in their form immediately preceding these amendments. Applicant reserves the right to pursue the original scope of these claims in the future, such as through continuation practice for example.

8.   Extension of time under 37 CFR 1.136(a).

A petition is enclosed for a one month extension as described in 37 CFR 1.136(a); an appropriate fee is enclosed.
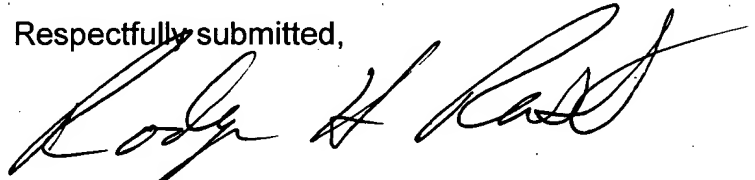
9. <u>Conclusion</u>.

Based on the foregoing, Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for the present Application to pass to issuance.

In the event any further matters remain at issue with respect to the present Application, Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this Application.

Date: _Sept. 2, 2005_

Respectfully submitted,

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Attachments:
    (1) Replacement sheets of drawings (sheets 1-9)
    (2) Electronic Data Marker Articles (14 pages)
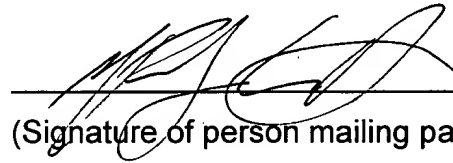
CERTIFICATION UNDER 37 CFR 1.8

I hereby certify that the foregoing: .

Amendment

is being deposited with the United States Postal Service on September 2, 2005 with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

ROBYN CARRILLO
(Type or print name of person mailing paper)

(Signature of person mailing paper)

Amendments to the Drawings:

Please accept the set of substitute drawings (sheets 1-9) which are enclosed; each marked at the top as "replacement sheet", to overcome 'informality' of prior drawings.   No new matter has been added. Approval of the replacement figure(s) is respectfully requested by the Applicant.

CERTIFICATION UNDER 37 CFR 1.8

I hereby certify that the foregoing:

Replacement Drawings

is being deposited with the United States Postal Service on **September 2, 2005** with
sufficient postage as first class mail in an envelope addressed to the: Commissioner
for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

ROBYN CARRILLO

(Type or print name of person mailing paper)

(Signature of person mailing paper)
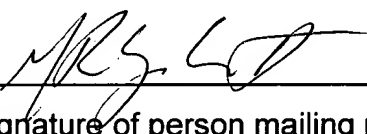
CERTIFICATION UNDER 37 CFR 1.8

I hereby certify that the foregoing:

Appendix to amendment: Electronic Data Marker Articles

is being deposited with the United States Postal Service on September 2, 2005 with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

<u>   ROBYN CARRILLO   </u>

(Type or print name of person mailing paper)

<u>   </u>

(Signature of person mailing paper)